

REMARKS

Claims 1-22 and 24-25 are pending in this application. Claim 23 has been canceled.

Restriction of the claims and election of species

The Examiner indicates that Applicants have elected the species diethyl-2-phenyl-(3-picolyl) malonate as the species with which to begin examination. Applicants confirm election of the indicated species.

The Examiner further advises that the election of species has been used to "create a natural genus under the guidelines of 35 U.S.C. 121." The Examiner has restricted the claims into the following groups.

I. Claims 1, 2, 4, 5, 6, 8, 9, 15, 16 and 21-25 wherein A (CH₂)₀₋₅, R₁ carbocyclic ring, R₂ is pyridyl, and R' is as claimed; and

II. Claims 3, 7, 10, 11, 12, 13, 14, and 17-20, wherein R₁-R₄, R', R'', A and B are all other moities.

Applicants traverse this restriction and careful review and reconsideration thereof by the Examiner is respectfully requested. Applicants note that there are several problems with this restriction. For example, the Examiner does not indicate which

substituent groups for B, R3 and R4 are included in the respective groups.

In addition, Applicants believe the restriction is substantively improper in because "A-C-B" of formula (I) makes up an identical core backbone for the compounds, such that if A and B are restricted to being (CH₂)₀₋₅, R1-R4 should not be restricted to particular groups. In addition, all of the compounds of the invention share a common utility as SK/IK/BK ion channel modulating agents. Withdrawal of the restriction requirement and rejoinder of all of the claims is therefore respectfully requested.

Rejections under 35 U.S.C. §101

Claim 24 has been rejected under 35 U.S.C. §101 as being an improper "use" claim. Claim 24 is properly drawn to a "method of treatment." Applicants believe that the rejection was intended to be directed to claim 23. Claim 23 has been cancelled, thus rendering the rejection moot.

Rejections under 35 U.S.C. §112, first paragraph

The Examiner rejects the claims under 35 U.S.C. §112, first paragraph for lack of enablement. More specifically, the Examiner asserts that the specification is not enabled for R1 or R2 as being "all mono- or polycyclic groups, mono or poly heterocyclic groups, aralkyl groups, or a heteroalkyl groups which may be optionally substituted." Applicants traverse the rejection and withdrawal thereof is respectfully requested.

The Examiner has improperly presented conclusory statements regarding the enablement of the invention with no basis or support for those statements.

It is incumbent upon the Patent Office, whenever a rejection on this basis [lack of enablement,] is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. In re Marzocchi and Horton, 169 USPQ 367 (CCPA 1971).

Applicants request that the Examiner either support the rejection with acceptable evidence or reasoning, in a non-final action, or withdraw the rejection.

Claim 24 has been rejected with the assertion that since there is no stated utility, one skilled in the art would not know how to

practice the invention. Applicants again believe this rejection was intended for claim 23, which has been cancelled. Withdrawal of the rejection is, therefore, respectfully requested.

Claim 25 has been rejected for lack of enablement with the assertion that the claim is not enabled for the treatment of all of the recited respiratory diseases. Applicants traverse this rejection and withdrawal thereof is respectfully requested. The Examiner again fails to,

explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. In re Marzocchi and Horton, 169 USPQ 367 (CCPA 1971).

The rejection, therefore, must be withdrawn. In addition, the specification provides evidence supporting the enablement of the invention of claims 24 and 25. Example 15 demonstrates that the compounds of the invention are inhibitors of the $I_{K_{Ca}}$ channel. It is well known in the art that inhibitors of the $I_{K_{Ca}}$ channel are accepted as being useful in treating diseases of Claims 24 and 25. As such, the invention is fully enabled as claimed and withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. §112, second paragraph

Claims 1, 2, 4-6, 8, 9 and 16 have been rejected under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, the claims have been rejected for recitation of mono- or polycyclic groups, mono or poly heterocyclic groups, aralkyl groups and heteroalkyl groups with the assertion that these groups are indefinite. Applicants traverse this rejection and withdrawal thereof is respectfully requested. The terms that the Examiner asserts as being indefinite have well-known and accepted definitions in the field of chemistry. For Example, attached hereto is an excerpt from the Grant & Hackh's Chemical Dictionary, wherein the terms "hetero", "aryl", "alkyl" and "cyclic" are defined. As such, the invention as claimed is fully defined and withdrawal of the rejection is respectfully requested.

Claim 21 has been rejected as being indefinite in the failure to recite that the composition is for administration to a host in need thereof. Claim 21 has been amended to recite "in a patient in need thereof." Withdrawal of the rejection is therefore respectfully requested.

Rejections under 35 U.S.C. §102(b)

Claims 1, 2, 4-6, 8 and 16 have been rejected under 35 U.S.C. §102(b) as being anticipated by Morisawa et al. Morisawa et al. is asserted to teach propanedioic acid (4-fluorophenyl)(3-pyridinylmethyl)-diethyl ether, which is encompassed by the present claims. Applicants traverse this rejection and withdrawal thereof is respectfully requested.

The present invention is drawn to malonic acid esters having IK_{Ca} channel modulating activity. Morisawa et al. is drawn to renin-inhibitory oligopeptides, which have nothing to do with the present invention. See Abstract. In addition, in making the assertion that Morisawa et al. discloses propanedioic acid (4-fluorophenyl)(3-pyridinylmethyl)-diethyl ether of the present invention, the Examiner cites the entire 111 page document of Morisawa et al., without specifically pointing out where the Examiner believes that present invention is disclosed in the reference. As far as Applicants are able to tell there is neither disclosure nor suggestion of the invention in Morisawa et al. As such, the Examiner is requested to either withdraw the rejection or point out with particularity where the reference discloses the present invention.

Amendment to claim 22

The Examiner indicates on page 7 of the Office Action that claim 22 was missing from the amendment of paper No. 5, i.e. the Preliminary Amendment of May 15, 2001. Applicant note for clarification of the record that claim 22 was not included in the May 15, 2001 Preliminary Amendment because the claim was in no way amended.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong, PhD (Reg. No. 40,069) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), the Applicants hereby petition for an extension of two (2) months to February 13, 2002 in which to file a reply to the Office Action. The required fee of \$400.00 is enclosed herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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GMM/MAA
2815-0159P

Attachment: Version with Markings to Show Changes Made
Copy of Chemical Dictionary, pp.24, 53, 167, 282

(Rev. 09/26/01)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 23 has been canceled.

Claim 21 has been amended as follows:

21. (Twice Amended) A pharmaceutical composition comprising a therapeutically effective amount of a chemical compound represented by the general formula I of claim 1, or a pharmaceutically-acceptable addition salt thereof, together with at least one pharmaceutically-acceptable carrier or diluent, for the treatment or alleviation of a disease or a disorder or a condition responsive to modulation of SKCa, IKCa and/or BKCa channels in a patient in need thereof.